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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/698,454 10/27/00 SEIBERG

M JBP0518

EXAMINER

HM12/0628

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LAMM, M

ART UNIT

PAPER NUMBER

1616

DATE MAILED:

06/28/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)	
	09/698,454	SEIBERG ET AL.	
	Examiner	Art Unit	
	Marina Lamm	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- | | |
|---|--|
| 15) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 20) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-25 are pending in this application filed 10/27/2000.

Priority

1. If applicant desires priority under 35 U.S.C. 119 (e) based upon a previously filed copending application, specific reference to the earlier filed application must be made in the instant application. This should appear as the first sentence of the specification following the title, preferably as a separate paragraph.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-12 and 15-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 25 use improper Markush claim language: "selected from the group consisting of an antioxidant, a chelating agent, or a preservative". Proper Markush claim language is : "selected from the group consisting of A, B, C and E" or "is A, B, C or E".

Claims 2-12 and 15-24 are being rejected because they contain all the limitations of Claim 1 from which they depend.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-10 and 12-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over either De Stoutz (US 5,503,832) or JP 62036304 (Abstract) in view of Bissett et al. (US 6,183,761) and Knight et al. (US 6,017,549).

De Stoutz teaches using soymilk in skin care products and other cosmetic products. See col. 4, lines 1-5. JP 62036304 (Abstract) teaches using soybean milk in cosmetic compositions for skin and hair.

Neither reference explicitly teaches a stabilizing system of the instant invention.

However, the claimed stabilizing system comprising an antioxidant (e.g. retinol, tocopherol, BHT), a chelating agent (e.g. EDTA and its salts) and/or a preservative (e.g. parabens) is known and widely used in the art of cosmetic compositions for the purpose of stabilizing active ingredients. See, for example, Bissett et al. at col. 10, lines 47-50; Examples, and Knight et al. at col. 4, lines 33-37; Example I.

With respect to Claim 12, Bissett et al. teach using thickening agents in order to achieve the desired viscosity of the cosmetic compositions. See col. 10, lines 1-5.

With respect to Claim 24, Bissett et al. teach using caffeine as anti-cellulite agent. See col. 10, line 57. Knight et al. also teach cosmetic compositions containing caffeine powder. See Example I.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to use stabilizers, thickeners and/or caffeine of Bissett et al.

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and Knight et al. either alone or in mixtures in cosmetic products of De Stoutz or JP 62036304 for their art-recognized purpose. The selection of a known material based on its suitability for its intended use is obvious absent a clear showing of unexpected results attributable to the applicant's specific selection.

With respect to Claim 2 which recites no more than 0.1% of a surfactant, it would be conventional and within the skill of an ordinary practitioner to determine the optimal concentration of a surfactant depending on the desired properties of the final product.

With respect to Claims 15-22, the cosmetic compositions of De Stoutz or JP 62036304 are inherently applied to the skin. When applied to the skin, the cosmetics of De Stoutz or JP 62036304 will inherently produce the claimed results. Since the method step is the same, the result will inherently be the same.

6. Claims 1-9, 11 and 13-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al. (KR 9208853, Abstract) in view of Bissett et al. and Knight et al.

Lee et al. teach using soybean powder in cosmetics.

Lee et al. do not explicitly teach a stabilizing system of the instant invention.

However, the claimed stabilizing system comprising an antioxidant (e.g. retinol, tocopherol, BHT), a chelating agent (e.g. EDTA and its salts) and/or a preservative (e.g. parabens) is known and widely used in the art of cosmetic compositions for the purpose of stabilizing active ingredients as taught by Bissett et al. and Knight et al. and discussed above. Bissett et al. and Knight et al. also teach caffeine as discussed above.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to use stabilizers and/or caffeine of Bissett et al. and Knight et

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al. either alone or in mixtures in cosmetic products of Lee et al. for their art-recognized purpose. The selection of a known material based on its suitability for its intended use is obvious absent a clear showing of unexpected results attributable to the applicant's specific selection.

With respect to Claim 2 which recites no more than 0.1% of a surfactant, it would be conventional and within the skill of an ordinary practitioner to determine the optimal concentration of a surfactant depending on the desired properties of the final product.

With respect to Claims 15-22, the cosmetic compositions of Lee et al. are inherently applied to the skin. When applied to the skin, the cosmetics of Lee et al. will inherently produce the claimed results. Since the method step is the same, the result will inherently be the same.

Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Conclusion

7. No claim is allowed at this time.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 5,916,577; US 6,183,762; JP 2804312 (Abstract); JP 409077638 (Abstract).

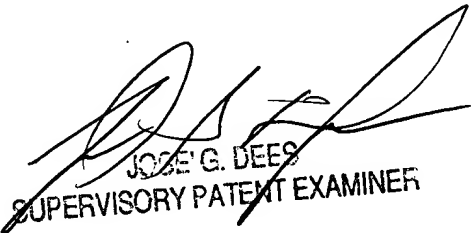
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (703) 306-4541. The examiner can normally be reached on Monday to Friday from 9 to 5.

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The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

ml
6/26/01


JOSE G. DEES
SUPERVISORY PATENT EXAMINER
1616